

## **REMARKS**

### **Response to Priority**

The Examiner contends that there are numerous co-pending applications which disclose and claim very similar an/or identical subject matter to that of the present application. However, the present application calls for a tissue damager that operates in conjunction with a tissue cutting member. Additionally, applicants have concurrently withdrawn their claim of priority to all of the prior related applications except for the immediate parent applications, namely Serial No. 09/884,349 and Serial No. 09/238,965 as indicated in the amendment to Related Applications.

### **Response to Objections to the Specification**

The specification has been amended to overcome the Examiner's objections by updating the status of the patent applications referred to in the **RELATED APPLICATIONS**.

### **Response to Objection to Drawings**

The Examiner has objected to the drawings under 37 C.F.R. §1.83(a) contending that they do not show every feature claimed. In response thereto, applicants have added new drawing (Figure 11) which is Figure 6 of U.S. Patent No. 6,344,026 and a new paragraph on page 11 of the present application. The '026 patent was incorporated by reference into the present application. (See page 6, lines 17-22).

### **Response to Claim Rejections Under 35 U.S.C. §112**

Claims 19-21 and 25-39 were rejected by the Examiner under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner stated that the application as originally filed failed to disclose the specific

combination of steps including separating a tissue specimen, encapsulating the separated tissue, and damaging the separated tissue as now set forth in independent claim 19. The application as filed, however, includes reference to all three steps. In one embodiment of the invention, the application states that the tissue is ablated or otherwise damaged after isolation (page 7, lines 3-4). Additionally, the applications indicates that, "either before, during, or after isolation of the tissue specimen, the wires 28 are extended as shown, and enter the tissue specimen." (page 7, lines 12-13). The radiofrequency wires 28 are used to damage the tissue specimen.

The application also makes reference to encapsulation of the specimen indicating that the tissue specimen may be morcellated after encapsulation of the tissue specimen (page 10, line 19-20). Additionally in one embodiment of the invention a sheath may be used to at least partially surround the tissue specimen and in another embodiment the tissue specimen is physically isolated with a chemical that flows into the periphery channel about the tissue specimen (page 10, lines 1-7).

The Examiner stated that the specification does not disclose a device including separate tissue cutting, tissue encapsulating and tissue damaging devices as now set forth in independent claim 30. The application, however, contains disclosure of all three elements in claim 30. The tissue separation is performed with the tissue cutting element 22. Tissue encapsulation may be performed with a sheath which surrounds the tissue specimen or with a chemical that flows into the periphery channel about the tissue specimen (page 10, lines 1-7). Tissue damaging may be performed by the radio frequency wires 28 or the morcellator 222.

Because the application discloses all three steps discussed in claim 19, and discloses a device including separate tissue cutting, tissue encapsulating, and tissue damaging devices as set forth in claim 30, the application is in compliance with 35 U.S.C. §112 (first paragraph). Additionally, on page 6, lines 17-22 of the present application, reference is made that the tissue specimen isolating tools with cutting members described in U.S. Serial No. 09/057,303 and U.S. Serial No. 09/208,535 (now U.S. Patent No. 6,344,026) may be employed with the present invention. Both applications were incorporated by reference. U.S. Patent No. 6,344,026 discloses a isolating tool with both a cutting member and an encapsulation system. Figure 6 of the '026 patent has been added to the present application as Figure 11. The isolation tools would be employed with the embodiments of the present application. Those skilled in the art would easily employ the arcuate tissue cutter and encapsulation system shown in the '026 patent with the embodiment shown in Figure 1 of the present application.

#### **Response to Claim Rejections Under 35 U.S.C. §102**

Claims 1 and 22-34 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by Kresch et al. (U.S. Pat. No. 5,527,331). Claims 1 and 22-24 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by Savage et al. (U.S. Pat. No. 6,032,673).

The Kresch reference discloses a method wherein tissue separated from the body is drawn directly into an aspiration lumen, but there is no suggestion of damaging the tissue specimen with a tissue damager which is located at the distal operational portion. Similarly the Savage reference does not disclose a method wherein the at least partially isolated tissue specimen is damaged. Neither the Kresch reference nor the

Savage reference disclose, teach or suggest all of the features of the above claims, therefore applicants submit the reference does not anticipate these claims.

### **Response to Double Patenting**

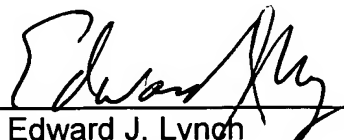
Claims 1 and 22-24 were rejected by the Examiner on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,659,105. In response applicant's counsel has filed herewith a Terminal Disclaimer (By Attorney) directed to the '105 patent.

Claims 1 and 22-24 were rejected by the Examiner on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,676,658. In response applicant's counsel has filed herewith a Terminal Disclaimer (By Attorney) directed to the '658 patent.

### **Conclusion**

The applicants believe the pending claims are patentable over the cited references. Reconsideration and an early allowance are earnestly solicited.

Respectfully submitted,

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**IN THE DRAWINGS**

**Please add new drawing 11 attached hereto:**